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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/916,919

07/27/2001

Shu Lin

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09/21/2005

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PATENT OPERATIONS
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EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,919

Applicant(s)

LIN, SHU

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Y

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

Response to Arguments

1. Applicant's arguments filed 6/24/05 have been fully considered but they are not persuasive.

{A} In re page 2-6, applicant recites case Law, which states for a 102 rejection to disclose each and every element and at page 3 makes a showing of the specification drawing relevance that the prior art and the specification are distinguishable.

In response the examiner agrees.

Although the examiner's analysis is in light of the specification, but, the scope of the invention is determined with respect to the claim language used, wherein the examiner does not inject all detail from the specification in the claims, as it is deemed improper, wherein the examiner provides support below.

The scope is determined in view of the claim language used and obviousness is based on the references as deemed modifiable based on what is known and deemed obvious to those skilled in the art, wherein the examiner's analysis is based on high sight.

In response to applicant's arguments and suggestions that the references fail to show certain features of applicant's

invention, it is noted that the features upon which applicant relies (i.e., the details of the specification argued) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument and suggestions that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

{B} In re page 3, applicant states, "... multimedia inputs can be audio, video or a combination thereof."

In response the examiner agrees again with the statements made.

Fig. 1 of applicant shows 6 inputs, three video and three audio, but the claims fails to claim, "6 inputs", but recites "multimedia inputs", the scope of the claim language used is met

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by two or more inputs, with no definition or limitations on how many video and audio, but merely requires two.

Claim 1, fails to define if the inputs are video or audio or even how many video vs. audio, merely claiming a plurality of multimedia inputs, therefore, Fig. 2 of Tanaka, having three video inputs for the three component of video and 4 audio inputs, reads on the claims as recited, the 7 inputs, 4 audio and 3 video inputs representing at least one video signal with three components, these inputs read on the claims in view of the definition provided by applicant, "... multimedia inputs can be audio, video or a combination thereof", therefore this limitation is reasonable, read in light of the specification, but, is also commensurate with what the known definition, well known and established in the art.

Therefore, Tanaka, the examiner deems based on the claim language used reads on the claimed invention.

{C} In re page 8, applicant states, "There is absolutely no teaching, suggestion or anticipation in Tanaka for such, "sampling the multi-media inputs contain a portion of the plurality of multimedia inputs.", and "In Tanaka the digitized signals contain all of the sampled signals and not a portion of the plurality of multimedia inputs.".

In response the examiner cites:

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Park 5,093,750, col. 4, "analog/digital converter 60 for sampling and holding said composite video signal according to the sampling frequency of the oscillator 100 and converting said signal into digital data by quantimization".

Two issues are raised by the examiner, the first is that every A to D, performs sampling, which is sampling at certain points, not every point, creates a signal representative of the analog, but, as all skilled in the art realize, based on the Education having a Bach. degree in Electrical Engineering, the A to D process with respect to any sampling frequency, only a portion or representation of the analog is generated, based on the electrical engineering knowledge, as those skilled in the art realize without question.

In view of claim analysis and patent examining, a portion can be the whole portion, but in this case is just a sampled version of the analog input, thereby sampling at times dictated by the oscillator, therefore sampled portions are generated by the A to D converters, with respect to the multimedia inputs.

Therefore, A to D converters since sampling, only generate discrete signals from the continuous analog input signal, therefore, sampled signals are only sampled portions of the analog signal in time, based on the rate is sampling and the

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resolution used, of the continuous analog signals, deemed to read on the claim language as presently recited.

{D} In re page 10, applicant states, "In Tanaka, however encoders 100 and 101 are cited by the examiner but the encoding process is not explained or taught in Tanaka.", and "Tanaka ... instead teaches that a signal video ... and audio are encoded and does not teach a plurality of multimedia inputs are simultaneously encoded.".

In response can applicant cite claim language with respect to the encoder, that requires more than the reciting of an encoder.

Why does the examiner need more detail than the claim language used???

The examiner cites, col. 5, lines 13-20, "the operator selecting the 2 channel audio mode or the 4 channel audio mode", the examiner is confused that somehow one skilled in the art could even come to a conclusion that either two or 4 channel audio modes that the signals are not simultaneous received.

The examiner could never state that the 2 or 4 multimedia audio inputs modes, with 3 video components are not simultaneously received, sampled, processed and encoded by encoding elements, please refer to col. 5 etc..... and elements in Fig. 2, such as 79, 78, 102, the signals are

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simultaneously received (54, 55, 56, 60, 61, 62, 63, 64), sampled (54, 55, 56, 66, 67, 68, 69), possible processed by compression encoding (57, 58, 59, 72, 73, 74, 75), merged or encoded (78, 79, 102) and encoded (100, 101) and merged or encoded, to tape 105.

For the record encoding is defined as changing the form from one to another, while decoding is narrower, which means bring back to the form prior to encoding, A to D and D to A, compression, merging, even separating elements can all be referred to as encoding elements, not limited to video or audio compression, as those skilled in the art of patent examiner realize.

Also in view of merging elements and that video and audio have relevance in time, such as tip syncing, having the audio at desired times or related to times of both signals, there is no question that the multimedia inputs are simultaneously received, processed and recorded in view of Tanaka, if applicant fails to agree please provide cols. and lines in Tanaka that support the arguments made.

{E} In re page 10, applicant states that Tanaka teaches away under the 102 rejection claim 1.

The examiner does not understand the point, teaching away issues are deemed to be a 103 issue, which require that the

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reference to state not to do a teaching in view of non desirable results, citing passages such as this may be persuasive, but, not always, "it is analyzed on a case by case basis", in a 103 combination and is deemed not relevant in a 102 rejection.

Applicant has cited nothing from the reference and the rejection argued is 102 limitations of Tanaka.

{F} In re pages 11-, applicant argues the 103 rejections based on motivation, that there is no motivation to combine.

In response the examiner had carefully considered all 103 issues and fails to agree.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Therefore, since the claims are not amended and the statements and arguments presented are not persuasive this action is made final.

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The examiner believes that an amendment directed to the differences between the Tanaka and the disclosed invention of this application, Tanaka can be overcome and the claims can be written directly to the differences and be patentable distinct with respect to least the prior art Tanaka, as the examiner and applicant clearly realize, but at this point the claims are not deemed distinguishable, but the specification is.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 6-7, 12-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka (US 5,764,847).

Since not amended the examiner incorporates by reference the last action against the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,764,847) in view of Campbell et al. (US 4,967,271).

Since not amended the examiner incorporates by reference the last action against the claims.

5. Claims 5, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,764,847) in view of Sato et al. (US 5,566,174).

Since not amended the examiner incorporates by reference the last action against the claims.

6. Claims 8-9, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,764,847).

Since not amended the examiner incorporates by reference the last action against the claims.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Fax Information

Any response to this action should be faxed to:
(571) 273-8300, for communication as intended for entry,
this Central Fax Number as of 7/15/05

Contact Information

Any inquiry concerning this communication or earlier
communications should be directed to the examiner of
record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00
PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
9/18/05


VINCENT BOCCIO
PRIMARY EXAMINER